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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,370	07/18/2003	Zane Vella	021572-000210US	4363

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EXAMINER

SMITH, PETER J

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,370

Applicant(s)

VELLA ET AL.

Examiner

Peter J. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: application filed 7/18/2003, provisional application filed 8/8/2002.
2. Claims 1-48 are pending in the case. Claims 1, 13, 21, 25, 32, 35, and 43 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-30, 32, 33, and 35-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. (hereinafter “Gupta”), US 6,546,405 B2 filed 10/23/1997.**

Regarding independent claim 1, Gupta discloses displaying an audiovisual production in fig. 2, col. 2 lines 36-64, and col. 5 line 19 – col. 6 line 64. Gupta discloses displaying a message relating to a portion of the audiovisual presentation in fig. 2, col. 2 lines 36-64, col. 5 line 19 – col. 6 line 64, and col. 18 line 5 – col. 19 line 31.

Regarding dependent claim 2, Gupta discloses wherein the message is alphanumeric text displayed in a text window in fig. 2, 3, col. 6 line 43 – col. 7 line 34, and col. 9 line 61 – col. 10 line 14.

Regarding dependent claim 3, Gupta discloses accepting a signal from a viewer input device to resize an area used to display the audiovisual production in col. 5 lines 19-63. Gupta discloses accepting a signal from a viewer input device to allow resizing of the text window in col. 6 lines 43-64 and col. 9 line 61 – col. 10 line 14.

Regarding dependent claim 4, Gupta discloses wherein the message includes a reference to a second portion of the audiovisual production in col. 9 line 45 – col. 10 line 30.

Regarding dependent claim 5, Gupta discloses wherein the message includes an icon defining a portion of the audiovisual production to be displayed upon selection of the icon in col. 9 line 45 – col. 10 line 30.

Regarding dependent claim 6, Gupta discloses wherein at least a portion of the message is superimposed over the display of the audiovisual production in fig. 9, 10, col. 18 line 34 – col. 19 line 31.

Regarding dependent claim 7, Gupta discloses displaying a plurality of headers, each of which corresponds to a message and related messages in fig. 3 and col. 9 line 45 – col. 10 line 64. Gupta discloses accepting signals from a viewer input device to select a header in col. 9 lines 45-60. Gupta discloses expanding the message and related messages corresponding to the selected header so that details of the message and related messages are displayed in fig. 3, col. 9 line 45 – col. 10 line 64, and col. 15 line 64 – col. 18 line 4.

Regarding dependent claim 8, Gupta discloses wherein the messages are generated by an instant messaging system in col. 18 line 5 – col. 22 line 63.

Regarding dependent claim 9, Gupta discloses wherein the messages are generated by a chat room system in col. 18 line 5 – col. 22 line 63.

Regarding dependent claim 10, Gupta discloses wherein the messages are generated by an electronic mail system in col. 18 line 5 – col. 22 line 63.

Regarding dependent claim 11, Gupta discloses wherein the messages are generated by a message board system in col. 18 line 5 – col. 22 line 63.

Regarding dependent claim 12, Gupta discloses displaying a plurality of headers, wherein each header corresponds to a message and related messages and corresponds to a point in time in the playback of the audiovisual production in col. 9 line 4 – col. 10 line 64 and col. 15 line 64 – col. 19 line 31. Gupta discloses accepting a signal from a viewer input device to select a header and displaying, in response to the accepted signal to select a header, a portion of the audiovisual production beginning with the point in time corresponding with the selected header in col. 15 line 64 – col. 19 line 31.

Regarding independent claim 13, Gupta discloses associating a given message with a determined point in time of the playback in fig. 2, 3, 9, 10, col. 6 line 65 – col. 8 line 54, and col. 15 line 64 – col. 19 line 31. Gupta discloses displaying the given message at the determined point in time during the playback in col. 15 line 64 – col. 19 line 31.

Regarding dependent claim 14, Gupta discloses wherein the playback occurs using media accessed local to a display system in fig. 1B, col. 5 lines 7-12, and col. 23 lines 56-62.

Regarding dependent claim 15, Gupta discloses wherein playback occurs using media accessed remotely from a display platform in fig. 1C and col. 4 line 64 – col. 5 line 18.

Regarding dependent claim 16, Gupta discloses wherein the process of associating comprises using time codes in fig. 3, 8, col. 9 lines 25-35, and col. 18 line 59 – col. 19 line 18.

Regarding dependent claim 17, Gupta discloses wherein the process of associating comprises using DVD index information in fig. 3, 8, col. 9 lines 25-35, col. 18 line 59 – col. 19 line 18, and col. 23 lines 56-62.

Regarding dependent claim 18, Gupta discloses wherein the playback comprises accessing a CD-ROM in col. 8 lines 20-22.

Regarding dependent claim 19, Gupta discloses wherein playback comprises accessing a DVD in col. 23 lines 56-62.

Regarding dependent claim 20, Gupta discloses wherein the process of displaying the given message comprising using a threaded messaging system in col. 8 lines 29-54 and col. 19 lines 32 – col. 22 line 63.

Regarding independent claim 21, Gupta providing playback of an audiovisual production on a display system in fig. 2, col. 2 lines 36-64, and col. 5 line 19 – col. 6 line 64. Gupta discloses displaying a viewer generated message regardless of the display system at a pre-determined point in time of the playback in fig. 2, col. 2 lines 36-64, col. 5 line 19 – col. 6 line 64, and col. 18 line 5 – col. 19 line 31.

Regarding dependent claim 22, Gupta disclosing storing a plurality of the messages on a server remote from the display platform in fig. 1C and col. 4 line 64 – col. 5 line 18. Gupta discloses transferring a first portion of the messages from the server to the display platform when playback is initiated in col. 15 line 64 – col. 19 line 31.

Regarding dependent claim 23, Gupta discloses transferring a second portion of the messages from the server to the display platform in response to playback of the audiovisual production reaching a selected time code in col. 15 line 64 – col. 19 line 31.

Regarding dependent claim 24, Gupta discloses ranking the plurality of messages in accordance with a viewer selected criteria, defining a threshold, and transferring a portion of the ranked messages from the server to the display platform when playback where each of the ranking messages have a rank above the threshold in col. 9 lines 36-44.

Regarding independent claim 25, Gupta discloses a viewer interface in fig. 1, 2, and col. 5 line 19 – col. 6 line 64. Gupta discloses a receiving system for receiving a signal from the viewer interface to define a message during playback of the audiovisual production in col. 6 line 65 – col. 8 line 54. Gupta discloses a determination system to associate the message to a point in the pre-recorded media in col. 6 line 65 – col. 8 line 54 and col. 9 lines 25-35. Gupta discloses a storage system for storing the message along with an indication of the associated point in the playback in fig. 4, 8, and col. 10 line 65 – col. 11 line 35. Gupta discloses a displaying system for display the message in a window adjacent to a window displaying the playback of the audiovisual production, and substantially at the associated point in time of the playback in fig. 2 and col. 18 line 5 – col. 19 line 31.

Regarding dependent claim 26, Gupta discloses wherein the storage system further comprises a peer-to-peer network accessible over the Internet in fig. 1A and col. 19 line 32 – col. 22 line 63.

Regarding dependent claim 27, Gupta discloses wherein the storage system further comprises a message server in fig. 4 and col. 10 line 42 – col. 11 line 35.

Regarding dependent claim 28, Gupta discloses a time code detector in fig. 3, 8, col. 6 line 65 – col. 8 line 54, and col. 9 lines 25-35. Gupta discloses a local memory for storing the messages in fig. 1B, 1C, col. 4 line 64 – col. 5 line 18, and col. 10 line 65 – col. 11 line 35.

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Gupta discloses a computer for associating at least one of the messages stored in the local memory with a corresponding time code and for displaying the message upon detection of the corresponding time code during playback of the audiovisual production in fig. 3, 8, col. 6 line 65 – col. 8 line 54, and col. 15 line 64 – col. 18 line 4.

Regarding dependent claim 29, Gupta discloses wherein the computer controls the duration of display for each of the messages and for ensuring a minimum display duration for each of the messages during playback of the audiovisual production in col. 18 line 5 – col. 19 line 31.

Regarding dependent claim 30, Gupta discloses wherein the computer further associated a ranking with each of the messages stored in the local memory in col. 9 lines 36-44.

Regarding independent claim 32, Gupta discloses receiving a signal from a viewer interface to define alphanumeric text in fig. 3, 8, col. 6 line 65 – col. 8 line 54, and col. 15 line 64 – col. 18 line 4. Gupta discloses displaying the defined alphanumeric text in a first display adjacent to a second display of the audiovisual production in fig. 2, col. 6 lines 43-64, and col. 18 line 5 – col. 19 line 31. Gupta discloses displaying a listing of the defined alphanumeric text adjacent to the second display of the audiovisual production in fig. 2, col. 6 lines 9-42, and col. 18 line 5 – col. 19 line 31.

Regarding dependent claim 33, Gupta discloses receiving one or more instructions for receiving messages from a message server remote from the computer readable medium in col. 19 line 32 – col. 22 line 63.

Regarding independent claim 35, Gupta discloses receiving a pre-recorded audiovisual production in fig. 1C, 2, and col. 5 line 19 – col. 6 line 64. Gupta disclosing a display for

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displaying the audiovisual production in fig. 1B, 2, and col. 5 line 19 – col. 6 line 64. Gupta discloses one or more instructions for receiving message threads from a message server in communication with the system, the message threads comprising commentary relating to the content of the audiovisual production and each of the message threads associated with a time code and selectively displayed on the display in combination with the playback of the audiovisual production in col. 8 lines 29-54 and col. 19 line 32 – col. 22 line 63.

Regarding dependent claim 36, Gupta discloses wherein the pre-recorded audiovisual production is recorded on a DVD in col. 23 lines 56-62.

Regarding dependent claim 37, Gupta discloses a master DVD player, a communication network, a plurality of slave DVD players coupled to the master DVD player by the communication network, and a server, coupled to the master DVD player and the slave DVD players by the communication network, for initiating a presentation of the audiovisual presentation in fig. 1A, 1C, col. 5 lines 7-12, and col. 23 lines 56-62.

Regarding dependent claim 38, Gupta discloses wherein the server further comprises a memory for storing a list of viewers and assigning a token to the viewer associated with the DVD player designated as the master DVD in fig. 1A, 1C, and col. 19 line 32 – col. 22 line 63.

Regarding dependent claim 39, Gupta discloses a plurality of DVD players, each having a DVD pre-recorded with the audiovisual production and communication network coupling the plurality of DVD players in fig. 1A, 1C, and col. 4 line 64 – col. 5 line 18. Gupta discloses a means for designating one of the plurality of DVD players as a master DVD where the master DVD controls the playback of the audiovisual production by each of the remaining plurality of DVD players in fig. 1A, 1C, and col. 19 line 32 – col. 22 line 63.

Regarding dependent claim 40, Gupta discloses a plurality of DVD players for displaying the audiovisual production and a means for conducting a group presentation of the audiovisual presentation among a group of geographically dispersed viewers where one viewer controls the operation of each of the plurality of DVD players in fig. 1A, 1C, col. 5 lines 7-12, and col. 23 lines 56-62, and col. 18 line 5 – col. 22 line 63.

Regarding dependent claim 41, Gupta discloses wherein the pre-recorded audiovisual production is transmitted to the display system by a communication system selected from the group of cable, satellite or Internet communication networks in fig. 1A, 1C, and col. 4 line 64 – col. 5 line 18.

Regarding dependent claim 42, Gupta discloses wherein the playback comprises accessing a digital recording and player device in fig. 1B, 2, and col. 5 line 19 – 6 line 64.

Regarding independent claim 43, Gupta discloses providing a viewer with at least one message related to the audiovisual production, the message linked to a determined point in time of the audiovisual production in fig. 2, col. 8 lines 29-54 and col. 19 line 32 – col. 22 line 63. Gupta discloses initiating playback of the audiovisual production beginning at the determined point in time in response to a selection by the viewer in fig. 2, 3, 8, and col. 15 line 64 – col. 19 line 31.

Regarding dependent claim 44, Gupta discloses transferring the message to a display system from a message server and transferring the audiovisual production to the display system in fig. 1A, 1B, 1C, 2, col. 8 lines 29-54 and col. 19 line 32 – col. 22 line 63.

Regarding dependent claim 45, Gupta discloses wherein playback occurs using media accessed remotely from the display platform in fig. 1C and col. 4 line 64 – col. 5 line 18.

Regarding dependent claim 46, Gupta discloses wherein the message includes an embedded icon so that when the icon is selected, playback of the audiovisual production jumps to the determined point in time in col. 9 line 45 – col. 10 line 30 and col. 15 line 64 – col. 18 line 4.

Regarding dependent claim 47, Gupta discloses wherein the determined point in time includes a beginning time for a portion of the audiovisual production playback in col. 9 line 45 – col. 10 line 30 and col. 15 line 64 – col. 18 line 4.

Regarding dependent claim 48, Gupta discloses wherein the determined point in time includes an end time for a portion of the audiovisual production playback in col. 9 line 45 – col. 10 line 30 and col. 15 line 64 – col. 18 line 4.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al. (hereinafter “Gupta”), US 6,546,405 B2 filed 10/23/1997 in view of Sipusie et al. (hereinafter “Sipusie”), US 2005/0234958 A1 with priority to PCT filed 12/7/2001.

Regarding dependent claim 31, Gupta teaches ranking the messages to determine priority of messages in col. 9 lines 36-44. Gupta does not teach monitoring the time code associated with each message and in the event that the duration of display for a first message overlaps with the display of a second message, displaying the first message if its ranking is higher than the second message and otherwise displaying only the second message. Sipusie does teach monitoring the time code associated with each message and in the event that the duration of display for a first message overlaps with the display of a second message, displaying the first message if its ranking is higher than the second message and otherwise displaying only the second message in paragraphs [0036]-[0038]. Sipusie uses the annotation rating so that only the highest rated annotations are displayed with the audiovisual production. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Gupta and Sipusie to have created the claimed invention. Gupta teaches in col. 9 lines 36-44 and col. 21 line 61 – col. 22 line 67 that a user may select only a portion of the annotations as desirable annotations to view with the audiovisual production. Thus, it would have been obvious and desirable to one of ordinary skill in the art at the time of the invention to have further enhanced the ranking and selection system of Gupta with the ranking and selection system of

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Sipusie such that only higher rated messages over an overlapping time are displayed as is taught by Sipusie in paragraph [0037].

Regarding dependent claim 34, Gupta teaches ranking the messages to determine priority of messages in col. 9 lines 36-44. Gupta does not specifically teach associating messages from the message server with karma points and displaying only those messages having karma points exceeding a pre-determined threshold. Sipusie discloses a message rating system functionally the same as the claimed karma points in paragraphs [0036]-[0038]. Sipusie uses the rating system such that only messages having a rating exceeding a pre-determined threshold are displayed. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Gupta and Sipusie to have created the claimed invention. It would have been obvious and desirable to one of ordinary skill in the art at the time of the invention to have further enhanced the ranking and selection system of Gupta with the ranking and selection system of Sipusie such that only higher rated messages above a threshold are displayed as is taught by Sipusie in paragraph [0037].

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Purnaveja et al., US 6,006,241 patented 12/21/1999 discloses production of a video stream with synchronized annotations over a computer network. Eberman et al., US 6,173,287 B1 patented 1/9/2001 discloses ranking multimedia annotations of interest. Chaddha et al., US 6,173,317 B1 patented 1/9/2001 discloses streaming and displaying a video stream with synchronized annotations over a computer network. deVries et al., US 6,332,144 B1 patented

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12/18/2001 discloses a technique for annotating multimedia. Obrador, US 2003/0191776 A1 filed 4/5/2002 discloses media object management. Barger et al. "Annotations for Streaming Video on the Web", CHI '99 Extended Abstracts on Human Factors in Computing Systems, ACM Press, published 1999, pages 278-279 discloses a collaborative video annotation system for both personal note-taking and for sharing notes.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Smith whose telephone number is 571-272-4101. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS
12/5/2005

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
12/7/2005